

### **Remarks**

This Amendment is responsive to the final Office Action mailed September 1, 2004. In this Office Action, claims 1-2, 10-14, 24 and 28 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,061,668 (hereinafter, "Sharow"); claims 1-3, 8, 16, 19, 20, 23, 25, 27, 28, 29, and 32 were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 4,404,639 (hereinafter, "McGuire") in view of Sharow; claims 1-3, 8, 10-16, 19-20, 23-29, 32-33 were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,370,454 (hereinafter, "Moore") in view of Sharow; and claim 15 was rejected under 35 U.S.C. §103(a) as being obvious over Moore in view Sharow and further in view of U.S. Patent No. 6,330,499 (hereinafter, "Chou").

As a result of this Amendment, Applicant hereby requests the entry of the amendments to claims 1, 16, 19, 20, 23 and 27 provided above. No new claims have been added and no claims have been canceled. Claims 1-3, 8, 10-16, 19-20, 23-29 and 32-33 therefore remain pending in the present application. Reconsideration of the instant rejections is respectfully requested in view of the amendments above and the remarks below.

#### **A. Interview Summary**

The undersigned kindly thanks Examiner Dixon for his time in preparing for and attending a 37 C.F.R. § 1.133 interview on November 29, 2004, in which the undersigned and Mr. Dixon discussed the substance of the above-noted rejections as well as the amendments provided above. In this interview, the undersigned and Examiner Dixon discussed distinctions between Sharow and each of the independent claims of the present application. The following remarks are intended to not only fully respond to the final Office Action dated September 1, 2004, but also provide a complete and accurate record of the substance of the interview conducted on November 29, 2004.

#### **B. Claims Status in view of Amendment file on June 7, 2004**

Applicant sincerely appreciates the Examiner's identification in paragraph 2 of the final Office Action of the patentability of claims 1-3, 8, 10-15, 23-29 and 32-33 over McGuire and Moore individually in view of Applicant's arguments in the Amendment filed on June 7, 2004. Also, in paragraph 2, the Examiner maintained the rejections to claims 16, 19 and 20 made in the

non-final Office Action mailed in this application on March 5, 2004 on the grounds that claims directed to an apparatus (e.g., system) must be distinguished from the prior art in terms of structure rather than function. Office Action, at page 2 (citing *In re Danly*, 263 F.2d 844, 847, 120 U.S.P.Q. 582, 531 (CCPA 1959)).

In response to the Examiner's remarks in paragraph 2, Applicant proposes amendments to claims 16, 19 and 20 in which the previously recited data collector, escalation module, mapping module and registration/communication module are re-written in means-plus-function language. Accordingly, with the amendments to both of these claims, Applicant hereby invokes 35 U.S.C. §112, para. 6 such that the functional recitations of both claims distinguish the claimed structures from the structures taught individually in McGuire and Moore. Claims 16, 19 and 20 are therefore patentable over McGuire and Moore as individual references for at least the same reasons as claims 1-3, 8, 10-15, 23-29 and 32-33.

#### **C. Claim Rejections under Sharow**

Notwithstanding the notice of patentability of claims 1-3, 8, 10-15, 23-29 and 32-33 over McGuire and Moore, the Office Action rejects all claims in the present application as being either anticipated by or obvious in view of Sharow. Even further, because Sharow was submitted by Applicant in an IDS on June 23, 2004, the Office Action was made final pursuant to MPEP §609(B)(2)(ii). These rejections are now respectfully traversed.

In general, the present invention is directed to monitoring services performed by field service providers in association with customer accounts. Each of the pending claims of the present application recites a management system that manages operations of these field service providers respective to the services provided for each of the customer accounts. The claims further recite collecting business data relating to at least one specific customer account and analyzing the business data to determine whether a time-critical situation exists in association with the customer account.

If a time-critical situation does indeed exist, the present invention takes measures to notify the management system of the time-critical situation by establishing a communication session with the management system during which advisory information indicative of the time-critical situation is submitted to the management system. As such, the management system is provided with the ability to address the time-critical situation in expedited fashion if warranted.

For example, the customer account may be past due, and by submitting this knowledge to the management system via the established communication session, the management system may take action, such as, for example, immediately issuing a past due notice or suspending the customer account such that field server providers will not provide a service thereto.

Sharrow, on the other hand, is concerned with a communication network for controlling the actual usage of various appliances, such as appliances being used in hotel rooms. The appliances are each communicatively connected to a central management computer that acts as a cashier for the appliances by prompting users with the cost for using the appliances and ensuring that payment is made in full satisfaction of the cost. For example, the central management computer can automatically debit a user's account for the cost of using a particular appliance. Additionally, the central management computer can accept credit card information via card readers on the appliances and provide the necessary authorization and debit transactions necessary to accept credit card payment from the user.

Distinctions between Sharrow and the claimed invention are now addressed in turn with separate reference to the §102 anticipatory rejections and the §103 obviousness rejections.

(1) Rejections under 35 U.S.C. §102(b)

A claim can be rejected as anticipated by a prior art reference only if each and every limitation “as set forth in the claim” is found in the reference. MPEP §2131 (citing *Verdegaal Bros. V Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d. 1051, 1053 (Fed.Cir. 1987)). Independent claims 1, 16, 23 and 27 each recite the collection of business data that is (1) related to a service being provided by a field service provider; and (2) associated with a specific customer account. The claims therefore explicitly set forth a meaning of “business data” for use in context with the present invention. While the instant rejections are based on the alleged teaching of business data in Sharrow, Col. 5, lines 29-36, there are no assertions in the Office Action that this data is in any way related to a service being provided by a field service provider, nor are there any assertions that this data is associated with a specific customer account.

Indeed, Sharrow does not teach providing a service to the appliance, and consequently does not teach a *field service provider*. The user in Sharrow is taught as being a guest in the room in which the appliance is located and the user is requesting use of the appliance. This data is thus concerned only with whether the user is authorized to use the appliance. Moreover, Applicant respectfully submits that this data is not associated with any specific *customer*

*account*, but rather is only associated with a specific appliance. For these reasons, Sharrows fails to teach the collection of “business data,” as explicitly set forth in each independent claim of the present application.

As amended above, independent claims 1, 16, 23 and 27 also recite determining whether the collected business data indicates a time-critical situation associated with the specific customer account to which the collected business data pertains. Insofar as Sharrows, Col. 5, lines 29-36 does not teach the collection of “business data” in the context recited in any independent claim of the present application, Sharrows further does not teach this recited determining act. The Office Action states that Col. 5, lines 37-41 in Sharrows provide such a teaching; however, this cited passage is only concerned with authorizing a user for an appliance. Again, Sharrows only teaches such authorization with reference to a particular appliance and not a specific customer account. Though it is believed that the claims as pending distinguish in this respect over Sharrows, Applicant hereby proposes amending claims 1, 16 and 23 to clarify this particular distinction.

In summary, Sharrows fails altogether to teach the collection and analysis of “business data,” as explicitly set forth in independent 1, 16, 23 and 27. For at least these reasons, Applicant submits that independent claims 1, 16, 23 and 27 are not anticipated by Sharrows and respectfully requests reconsideration of the instant rejections. Claims 2-3, 8, 10-15, 19-20, 24-29 and 32-33 each depend from claim 1, 16, 23 and 27 and, therefore, are distinguished over Sharrows as submitted in the preceding remarks.

(2) Rejections under 35 U.S.C. §103(a)

In addition to the anticipatory rejections noted above, the Office Action rejects all pending claims of the present application under 35 U.S.C. §103(a). These obviousness rejections are based on the premise that Sharrows teaches those limitations recited in the claims that Moore and McGuire individually fail to teach. As such, all pending claims are currently rejected under two separate obviousness rejections, one of which is based on a combination of Moore and Sharrows and the other of which is based on a combination of McGuire and Sharrows.

Applicant respectfully traverses these obviousness rejections on the basis that the Examiner has not established a *prima facie* case of obviousness. Specifically, the Office Action fails to prove that either of these combinations teach or suggest all limitations recited in any claim of the present application. See MPEP §2143.03 (citing *In re Royka*, 490 F.2d 981, 180

U.S.P.Q. 580 (CCPA 1974). Additionally, the Office Action fails to prove any suggestion or motivation in the cited references or in the knowledge generally available to one of ordinary skill in the prior art to combine either Moore or McGuire with Sharrow. See MPEP §2143.03 (citing *In Re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed.Cir. 1998)). Each of these basic criteria for finding a *prima facie* case of obviousness are now addressed in turn.

(i) The combinations of Moore-Sharrow and McGuire-Sharrow both fail to teach or suggest the collection of “business data,” as explicitly set forth all pending claims.

While admitting that neither Moore nor McGuire teach or suggest business data, the Office Action states that Sharrow teaches business data, and thus, combines Sharrow with Moore and McGuire separately to render the instant obviousness rejections. Specifically, paragraphs 5 and 6 state, “Sharrow (‘668) teaches appliances contacting central systems regarding business data, performing analysis of business data and sending time-critical advisory information, ..., for the benefit of remote billing for appliance use.” Col. 5, line 25 through Col. 6, line 24 of Sharrow are cited as providing these particular features; however, the Office Action is not explicit on which information in particular is being pointed to as “business data.” Indeed, this cited portion of Sharrow describes two forms of information - financial information and authorization information.

Keeping in mind that “[a]ll words in a claim must be considered in judging the patentability of that claims against the prior art,” MPEP §2143.03 (citing *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970) (emphasis added), Applicants respectfully disagree with the assertion that Sharrow teaches “business data, “as explicitly defined in any pending claim of the present application. Sharrow’s teaching of authorization information and the failure of this information to meet this explicit definition of “business data” is addressed in the foregoing remarks in response to the anticipatory rejection over Sharrow. The financial information is now addressed.

The financial information taught in Sharrow, Col. 5, line 25 through Col. 6, line 24 does not constitute business data in the context recited in any claim of the present application. That is, all claims explicitly recite a specific form of business data that *relates to a service being provided by a field service provider*. Sharrow’s financial information only relates to the cost of *using, and not servicing*, an appliance. Therefore, taken in context with other recitations of all

claims pending in this application, the financial information taught by Sharrows necessarily does not read on the recited “business data” pursuant to the rule of law promulgated in *In re Wilson*, cited above with reference to MPEP §2143.03.

Because Moore and McGuire also don’t teach business data, as already established, the combinations of Sharrows with Moore and Sharrows with McGuire cannot render obvious any claim in the present application under 35 U.S.C. §103(a). This much is true with respect to both forms of data - financial data and authorization data - disclosed in columns 5 and 6 of Sharrows.

(ii) There is no motivation, either in the references or in the prior art, to combine either Moore and Sharrows or McGuire and Sharrows.

The Office Action fails to establish the existence of a motivation or suggestion to combine Sharrows with either Moore or McGuire. Such a motivation or suggestion may be proven either explicitly in any of the references or implicitly from the knowledge generally available to one of ordinary skill in the prior art. In the present application, however, no such reason has been provided to explain the selection and combination of certain teachings from each applied reference. Indeed, none of these references contain an explicit statement that would lead one of ordinary skill in the art to combine Sharrows with Moore or Sharrows with McGuire to render the present invention obvious.

Additionally, the Office Action provides no proof that such a combination would have been implicitly realized by one of ordinary skilled in the art taking into context the nature of the problem, as a whole, solved by the present invention. See *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed.Cir. 2002). The only conclusion that can be reached from the alleged combinability of these references is impermissible hindsight gleaned from the present invention. See, e.g., *Ex parte Haymond*, 41 USPQ2d 1217, 1220 (BdPatApp&Int 1996) (the examiner “may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis.”). For at least these reasons, the instant obviousness rejections are believed improper for failure to establish a *prima facie* case of obviousness.

### Conclusion

This Amendment is believed to be fully responsive to all points raised in the final Office Action mailed September 1, 2004. Still, the Office Action may contain other arguments and rejections and that are not directly addressed by this Amendment due to the fact that they are rendered moot in light of the preceding arguments in favor of patentability. Hence, failure of this Amendment to directly address an argument raised in the Office Action should not be taken as an indication that the Applicant believes the argument to have merit. Furthermore, the claims of the present application may include other elements, not discussed in this Amendment, which are not shown, taught, or otherwise suggested by the art of record. Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability.

Should the Examiner have any remaining questions or concerns, he/she is encouraged to contact the undersigned attorney by telephone to expeditiously resolve such concerns. Other than the fee accompanying the RCE, no fees are believed due with this Amendment. However, if this is not the case, please charge any other required fees, including any extension fees under 37 C.F.R. §1.136(a) necessary to maintain pendency of the present application, to Deposit Account No. 13-2725.

Respectfully submitted,



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